

REMARKS

Claims 16 to 19 are added, and therefore claims 8 to 14 and 16 to 19 are currently pending and being considered, since claim 15 was previously withdrawn in response to a restriction requirement.

Reconsideration of the application is respectfully requested based on the following remarks.

With respect to paragraph four (4) of the Office Action, claims 8, 11, 12, 13 and 14 were rejected under 35 U.S.C. § 103(a) as unpatentable over Le, U.S. Patent No. 6,160,309 to Terasaki, US 2002/0011661.

In rejecting a claim for obviousness under 35 U.S.C. § 103(a), the office bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine the reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claim 8 is to a diode, comprising: a press-fit base including an axially extending mounting region to mount a semiconductor chip; a head wire provided with a head configured to be affixed to the semiconductor chip; and a stabilization arrangement which include at least a sleeve and an encapsulating material filling cavities; *in which the head wire includes a stepped wire connection having a region, which together with the sleeve and the press-fit base forms a housing, the cavities of the housing being filled with encapsulating material.* In this respect the Figures 1 and 2 display this region (21), and the specification at page 3, lines 10 to 16, describes this feature. In this way, less epoxy may be used, as explained in the specification of the present application.

In contrast, as to the secondary "Terasaki" reference, protuberance 6c is not shown as and is not disclosed as providing this function of a region, which together with the sleeve and the press-fit base forms a housing.

Accordingly, the references, whether taken alone or combined, do not disclose nor suggest the claim 8 feature of a region, which together with the sleeve and the press-fit base

forms a housing, as provided for in the context of claim 8. Claim 8 is therefore allowable, as are its dependent claims 9 to 14.

With respect to paragraph eighteen (18) of the Office Action, claims 9 and 10 were rejected under 35 U.S.C. § 103(a) as unpatentable over Le, U.S. Patent No. 6,160,309 to Terasaki, US 2002/0011661, and in view of Khandros, U.S. Patent No. 6,274,823.

Claims 9 and 10 depend from independent claim 8, and are therefore allowable for essentially the same reasons as claim 8, as presented, since the third-level "Khandros" reference does not cure – and is not asserted to cure -- the critical deficiencies of the "Le" and "Terasaki" references as to claim 8.

New claims 16 to 19 do not add any new matter and are supported by the present application. New claim 16 is like claim 8 except that it includes the features of claim 9 and 11. Accordingly, claim 16 is allowable for at least the same reasons as claim 8 (and claims 9 and 11), as are its dependent claim 17 (features correspond to claim 10), claim 18 (features correspond to claims 12 and 13), and claim 19 (features correspond to claim 14).

Accordingly, claims 8 to 14 and 16 to 19 are allowable.

CONCLUSION

Applicants respectfully submit that all pending and considered claims 8 to 14 and 16 to 19 of the present application are allowable. It is therefore respectfully requested that the rejections be withdrawn. Prompt reconsideration and allowance of the present application are therefore respectfully requested.

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Respectfully submitted,

By: _____

Gerard A. Messina
Reg. No. 35,952
KENYON & KENYON LLP
One Broadway
New York, New York 10004
(212) 425-7200

[Handwritten signature of Gerard A. Messina]
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